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David Kappos
Undersecretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office
United States Patent Office
Alexandria, Virginia

Via e-mail to: oath_declaration@uspto.gov

March 6, 2012

RE: Request for Comments on Proposed Rules to Implement Inventor's Oath or Declaration Provisions of Leahy-Smith America Invents Act

Dear Undersecretary Kappos,

BASF Corporation, headquartered in Florham Park, New Jersey, is the North American affiliate of BASF SE, Ludwigshafen, Germany. BASF Corporation and BASF SE will be collectively referred to as BASF in this letter. BASF is the world's leading chemical company, and has a portfolio ranging from chemicals, plastics and performance products to agricultural products, fine chemicals and oil and gas. As a reliable partner, BASF uses its innovation to help its customers in virtually all industries to be more successful. With its high-value products and intelligent solutions, BASF plays an important role in finding answers to global challenges such as climate protection, energy efficiency, nutrition, and mobility.

BASF files more than 1,000 patent applications per year with the United States Patent and Trademark Office and currently has over 10,000 pending published unexamined US patent applications. Further, BASF has close to 1,000 pending US trademark applications and registrations.

BASF appreciates the opportunity to provide these comments on the proposed rules to implement the inventor's oath or declaration provisions of the Leahy-Smith America Invents Act, as they relate to applications made by an assignee under 35 U.S.C. § 118.

Under the America Invents Act, § 118 was amended to delete all references to an inventor who refuses to execute an application and inventors who cannot be found or reached after diligent effort. There is thus no statutory support for imposing any requirement for a showing that an inventor refuses to sign or cannot be found after diligent effort on an assignee or on a person to whom the inventor is under an obligation to assign, when one of those entities wishes to make an application for a patent. The only person required to make any showing by 35 USC § 118, as amended, is one who has a sufficient proprietary interest **other than** an assignment or an obligation to assign. As of September 16, 2012, therefore, an assignee or a person to whom the inventor is obligated to assign has an affirmative right to make an application for patent.

Proposed rule 1.47 improperly equates an oath/declaration executed by an assignee under § 118 with the substitute statement of § 115 (d)(1), under the permitted circumstance of § 115 (d)(2)(B), *i.e.*, when the inventor is under an obligation to assign but refuses to make oath/declaration. Two sections of proposed rule 1.47 should be changed in order to comply with § 118.

First, proposed rule 1.47(a) should affirmatively state that the assignee, or a person to whom the inventor is under an obligation to assign, may execute the oath/declaration without petition. Proposed rule 1.47(a) imposes the hurdle that a showing must be made that the inventor refuses to execute the oath/declaration or that s/he cannot be found or reached after diligent effort. Section 118 imposes no such hurdle on the assignee or person to whom the inventor is obligated to assign.

Second, proposed rule 1.47(c) should be changed to state that the only party who is required to file a petition is one who “otherwise shows sufficient proprietary interest in the invention”. As written, proposed rule 1.47(c) improperly imposes a petition requirement on **any** oath/declaration executed pursuant to rule 1.47. The assignee of a patent application should be required to do no more than provide a copy of the assignment in order to perfect its right to execute the oath/declaration. The person to whom the inventor is under an obligation to assign should have to do no more than provide a copy of the inventor’s employment agreement to perfect its right to execute the oath/declaration. Furthermore, the “diligent effort” burden in rule 1.47(c)(3) disregards the black letter of § 118 as applied to any eligible entity wishing to execute an oath/declaration, since even one who otherwise shows sufficient proprietary interest need only make a showing that such action is appropriate to preserve the rights of the parties.

When an inventor assigns all of her/his rights to an invention (s)he no longer has a property interest in the invention or in the corresponding patent application. The assignee should be able to proceed to make the application, as contemplated in § 118, without unnecessary agency hurdles.

BASF suggests that proposed rule 1.47 be revised to omit any requirement that an assignee or person to whom the inventor is obligated to assign file a petition to execute the oath/declaration, a right affirmatively granted in § 118, as amended.

Respectfully submitted,

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Senior Attorney